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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 16

Application Number: 09/765,675
Filing Date: January 22, 2001
Appellant(s): DOUIN ET AL.

MAILED
JAN 29 2003
GROUP 2900

Louis M. Troilo
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on November 7, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-83 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

US 5,617,418	MATZIK ET AL.	2-1998
US 5,135,748	ZIEGLER ET AL.	8-1992

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EP 0842652 A1

RESTLE ET AL.

8-1996

EP 0780114 A1

SIMONNET

6-1997

Decoster et al., JP410338899A (English abstract of JP 10338899 A), (Dec. 22, 1998), abstract.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(A) Claims 1-19, 21, 22, 30-62, and 68-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Restle et al. (EP 0842652 A1) ("Restle" hereunder) in view of Ziegler et al. (U.S. Pat. No. 5,135,748) ("Ziegler").

This rejection is set forth in prior Office Action, Paper No. 5.

(B) Claims 23-29 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Restle and Ziegler as applied to claims 1-19, 21, 22, 30-62, and 68-83 above, and further in view of Simonnet (EP 078114 A1).

This rejection is set forth in prior Office Action, Paper No. 5.

(C) Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Restle, Ziegler, and Simonnet as applied to claims 1-19, 21-63, and 68-83 above, and further in view of Matzik et al. (U.S. Pat. No. 5,716,418) ("Matzik").

This rejection is set forth in prior Office Action, Paper No. 5.

(D) Claims 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Restle, Ziegler, Simonnet, and Matzik, as applied to claims 1-63 and 68-83 above, and further in view of Decoster et al. (Abstract, JP 10338899A) ("Decoster").

This rejection is set forth in prior Office Action, Paper No. 5.

(11) Response to Argument

Examiner takes the position that the prima facie cases of obviousness have been established in this case. Examiner asserts that the obviousness rejections in the Office action dated August 16, 2001 in fact complies with the legal standard as set forth in Graham v. John Deere Co., as the rejections are based on the specific evidences found in the references, which would have motivated a skilled artisan to combine the teachings therein. See 383 U.S. 1, 148 USPQ 459 (1966). Examiner maintains the position that the obviousness rejections are proper, and applicants have not met their burden of rebutting the prima facie obviousness by specifically showing any nonobvious or unexpected results of the present invention.

(A) Group 1: Claims 78-82

Applicants argue that the rejection does not address "at least one nonionic polymer comprising at least one hydrophobic block and at least one hydrophilic block". Examiner respectfully disagrees. The nonionic amphiphilic lipids disclosed in the Restle reference in fact include polymers such as polysiloxane. See US 6,039,936, (English equivalent of Restle, EP 0842 652 A1), col. 1, lines 59 – col. 2, line 67.

(B) Group 2: Claims 1-19, 21, 22, 30-62, 68-77, and 83

Applicants argue that there is no objective evidence showing the desirability of the proposed combination. In the contrary, examiner had indicated that cationic polymers are well known in cosmetic art, and that a skilled artisan using the cationic polymers as taught by Ziegler would expect advanced moisturizing effect and stabilizing effect.

Applicants argue that the examiner present two different proposition to maintain the rejection. Each argument was made as a separate response to two different arguments made by applicants, and does not in anyway negate the motivation to use the cationic polymers of Ziegler in combination with Restle formulation.

Examiner also notes that the examiner's arguments in the Office action dated February 12, 2002 has been misquoted. In contrary to applicants' assertion in the brief, p. 12, first full paragraph, the Office action dated February 12, 2002 in fact states that the rejection "should NOT be interpreted to mean that a routineer would pick the cationic polysaccharide only and leave out the quaternary ammonium functionalized phosphate esters" of the Ziegler patent. The rejection had indicated that the Ziegler reference teaches to use the cationic polymers with phosphate esters. Examiner asserts that the rejection is proper since the phosphate esters, while not a claimed limitation in the instant claims, may still be included in the scope of the present invention. See the term "comprising" in instant claim 1.

This proposition is not in anyway inconsistent with examiner's arguments in the advisory action. There the examiner clarified that the rejection is based on the motivation to employ the specific beneficial ingredients in Ziegler patent and not the entire emulsion formulations containing those components. This argument was made to refute applicants' assertion that the combination of the Restle and Ziegler references would be somehow inoperable allegedly because obviousness rejection proposes to combine the entire emulsion composition with the nanoemulsion formulations in Restle. See Applicants' Response, paper no. 10, (May 30, 2002), page 3, first full paragraph.

In response to applicants' assertion that the examiner's arguments in support of the rejection are legally incorrect, examiner believes that the prima facie cases of obviousness have been established in paper no. 5, fully supported by the objective evidences that a routineer would have been motivated to employ the Ziegler cationic polymers in the Restle invention.

Applicants also argue that Dubief et al. (US 6120757), which was cited in examiner's response to applicants' argument, fails to provide the evidence of obviousness in using the cationic polymers in the instant invention. The introduction of the Dubief reference in the advisory action was merely for the purpose of refuting the applicants' allegation of nonobviousness in using cosmetic ingredients in different type of formulations, and does not in anyway substitute the evidences found in Restle and Ziegler, which are already sufficient to establish the prima facie case of obviousness in this case. Examiner reiterates that the burden of showing nonobviousness in employing the cationic polymers of Ziegler in the nanoemulsion in Restle was on the applicants since the prima facie case of obviousness had been established in this case.

Applicants' contention that the examiner's rational is overbroad is also erroneous. The rejection was based on specific references meeting every limitation of the instant claims and an objective motivation to combine thereof.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the nanoemulsion and the cationic polymers of the instant invention are well known in cosmetic emulsion composition art, as taught by Restle and Ziegler. Examiner respectfully disagrees with applicants' assertion that the disclosure of the specifications shows unpredictability in adding the cationic polymers to nanoemulsions. Examiner views that the disclosure in the specification does not overcome the presumption of obviousness that a routineer who reads the Restle and Ziegler references would have found motivations to combine the Ziegler cationic polymers to the Restle nanoemulsion.

(C) Group 3: Claims 23-29 and 63

In response to applicants' argument that the ionic amphiphilic lipids in the Simonnet reference is only an optional ingredient, examiner refers to a specific example which contains the ionic amphiphilic lipids, and the disclosure in the reference which specifically teaches to incorporate the same. See US 6,120,778 (English equivalent of Simonnet, EP 0 780 114 A1), col. 3, line 55-col. 4, line 42; Examples 3. Simonnet teaches a transparent nanoemulsion comprising the components in Restle and additionally the ionic amphiphilic lipids recited in the instant claims. Examiner respectfully disagrees with applicants' assertion that the reference rejection fails to provide motivation to use the ionic amphiphilic lipids. It is specifically indicated in Example 3, which employs disodium salt of N-stearyl-L-glutamic acid in a

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nanoemulsion, that the composition is transparent. The burden was on applicants to show with clear and convincing evidence how the present invention is nonobvious or produces unexpected results over this evidence.

(D) Group 4: Claim 20

Examiner respectfully disagrees with applicants' contention that the rejection fails to address specific motivation to choose the anionic amphiphilic polymers in Matzik. A nanoemulsion comprising anionic amphiphilic polymers is taught in the combined references, particularly in Simonnet. Both of the Restle and Simonnet inventions are suitable for hair dyeing compositions. See Restle in '963 patent, col. 8, lines 21 –27; Simonnet in '778 patent, col. 5, lines 42-45. Matzik teaches that the anionic surfactants including alkyl ether citrates, a recited anionic amphiphilic polymer in the instant case, are useful in formulating hair-coloring composition. See Matzik, col. 2, lines 17 –38. Examiner views that a routineer would have found it obvious to substitute one conventional anionic amphiphilic polymer with another in formulating the cosmetic compositions taught in the prior arts in expectation of successfully producing compositions.

(E) Group 5: claims 64-67

Examiner respectfully disagrees with applicants' argument that the rejection lacks motivation to add aminosilicone with the combined references to produce cosmetic detergent compositions. The motivation to formulate a cosmetic detergent cosmetic is also found in Restle, the primary reference. See Restle in '968 patent, col. 8, lines 17 – 20; Example 5. DeCoster provides evidences that the claimed aminosilicone is old and

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well known in cosmetic detergent art. See also US 6,159,914 (English equivalent of DeCoster, JP410338899A); JP 10-338899. Examiner maintains the position that in view of the prior arts the addition of aminosilicone in formulating a cosmetic detergent composition would have been obvious to one having ordinary skill in the art at the time of the invention.

For the above reasons, it is believed that the rejections should be sustained.

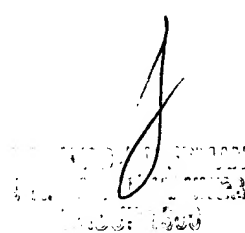
Respectfully submitted,


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January 27, 2003

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